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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,366	09/08/2003	Anthony J. Baerlocher	0112300-1630	9500

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BELL, BOYD & LLOYD LLP
P.O. Box 1135
CHICAGO, IL 60690

EXAMINER
MOSSER, ROBERT E

ART UNIT	PAPER NUMBER
3714	

NOTIFICATION DATE	DELIVERY MODE
12/17/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

CT

Office Action Summary	Application No.	Applicant(s)	
	10/657,366	BAERLOCHER, ANTHONY J.	
	Examiner	Art Unit	
	Robert Mosser	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30 and 32-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1-23,26,37-42 and 46-48* is/are allowed.

6)☒ Claim(s) *24,25,27-30,32-36 and 43-45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10-16-2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

The information disclosure statements (IDS) entered on October 16th, 2007 has been considered by the Examiner. A copy of the respective statement including the Examiner's notation is attached for the Applicant's records.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims **27-29, 34-36,** and **43-45** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims **27, 34,** and **43** now incorporate the language "predetermined" to describe the characterization of a symbol as a predetermined flanking or alternatively a predetermined convertible symbol. The applicant argues that the inclusion of this language would overcome the prior art, however upon review of the list claims in their entirety there is no basis for a determination of what time period for this association would necessarily constitute an association at a predetermined point. This language when read with the remainder of the claim fails to establish a temporal relationship between the characterization of the symbols and the remainder of the method steps. In accordance with the above the list claims are rejected for not clearly defining the claimed invention.

For the purposes of examination the symbol characterization is considered to be determined in the prior art of Gomez a the time, which the final reel arrangement is known to the gaming machine, and thus predetermined for the time period subsequent to their determination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **24-25, 27, 30, 34,** and **43** are rejected under 35 U.S.C. 102(e) as being anticipated by Gomez et al (US 7,077,745).

Claims **27,** and **34**: Gomez teaches a slot machine win completion feature including:

a plurality of reels (Figure 3);

a game operable upon a wager by a player(Abstract);

a plurality of symbols including Flanking symbols (Figure 4b Element 30), and non-flanking symbols wherein the non-flanking symbols further comprise a plurality of

similar or non-similar convertible (Figure 4b, Element 32, & Col 4:42 -57) symbols and nonconvertible (Figure 4b "fish food" and "gold fi$h") symbols; and

a processor to cause the generation of symbols on each of said reels and when a non-flanking convertible symbol appears on the same active payline as a flanking symbol (Figure 4b payline element 28) converting the convertible symbol into a flanking symbol (Figure 5, Element 34), in a manner appreciable to the player, and awarding any reward resultant of the conversion to the player (Abstract).

Claims **25,** and **43**: In addition to the above the invention of Gomez further includes the ability to make the described win completion feature an optional feature that would require player action such as a max bet to enable (Col 4:32-41) as the corresponding flanking and convertible symbols would not realized when this feature is not enacted by the player, the enactment of this feature by the player is understood to be equivalent to the player designation of a flanking and/or convertible symbol as claimed.

Claim **24**: In addition to the above the invention of Gomez sets forth spinning the reels (Col 3:6-23), and as best understood the Applicant's presented claim 24 sets forth steps (a) through (j) as the assignment and re-assignment of symbols to reel positions followed by a singular display step (k). Accordingly the presented claim is understood to describe the process of spinning the reels as set forth by Gomez.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **28-29, 32-33, 35-36,** and **44-45** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gomez et al (US 7,077,745). as applied to at least claims **1-27** above, and further in view of Brown et al (US 2003/0100356).

The invention of Gomez teaches the invention as taught above however is silent regarding the inclusion of an internet network, however in a related symbol conversion game Brown teaches the utilization of the internet network (*Brown* Paragraph 12). It would have been obvious to one of ordinary skill in the art, at the time of invention to have incorporated the use of the internet as taught by Brown in to the invention of Gomez to allow the utilization of the wagering platform for online casinos as taught by Brown.

Response to Arguments

In response to applicant's arguments directed to the amended language of Claim 24 that the inclusion of additional claim limitations under a statement of intended use (operable...to) , a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Claim 25 inherits the same issue through it's dependency.

With regards to the Applicant's amended language "predetermined" as presented in claims 27, 34 and 43, this characterization is not fairly defined with respect to the remainder of the claim language to support the separation as argued by the Applicant. Claims 28-29, 35-36, and 44-45 additionally fall on this issue through dependency.

With regards to claim 30, the amended claim language of allowing a player to designate does not limit the manner or method in which the designation process takes place. As previously presented in the non-final office action dated June 25th, 2007 the designation feature was presented as being inherent to the game operation since the designation as the Applicant described flanking and convertible symbols is resultant of the positioning of the symbol on the reels in the prior art and as the game play is further resultant of operation by the player. The player serves to designate the Applicant described flanking and convertible symbols through the activation of the gaming device.

Allowable Subject Matter

Claim **1-23, 26 37-42,** and **46-48** allowed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/RM/
December 7th, 2007

ROBERT E. PEZZUTO
SUPERVISORY PRIMARY EXAMINER